

REMARKS

By this Amendment, claims 2, 13-14, and 25-26 are canceled and claims 1, 6, 12, 16, and 24 have been amended. Claims 1, 3-12, and 15-24 are pending.

§ 102 Rejection of the Claims

Claims 1, 3-8, 10, 12-20 and 22-26 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Desai, U.S. Patent No. 6,231,591. Applicants respectfully traverse this rejection to the extent the rejection is considered applicable to the claims as amended. Desai fails to disclose each and every feature of the claimed invention as required by 35 U.S.C. §102(b).

Claims 13-14 and 25 have been canceled and independent claims 1, 12, and 24 have been amended to include the use of a spring mechanism and an actuator to bias a needle into the prostate gland upon actuation. In the Office Action, the Examiner takes the position that Desai discloses a system for delivering a denervating agent to a prostate gland that includes a spring mechanism and an actuator and refers to Col. 19, lines 31-32 and Fig. 25 for support. Applicants have reviewed the specification of Desai and fail to see where a spring mechanism and an actuator for spring biasing the needle into the prostate gland or other tissue is disclosed. The paragraph of the Desai specification that includes the sentence found at lines 31-32 relates to the an embodiment of the Desai system shown in FIG. 27, where the electrode 306, which in this embodiment may be a needle electrode, is coupled to a pin 396 connected to line 398 leading to pin 400 of connector 346. In this embodiment, as described, the pin contacts the electrode in operation and according to the specification "[t]he contact of pin 396 to electrode 306 must allow for the movement of the electrode." Nowhere does the specification indicate that the pin itself moves the electrode. In fact, the specification of Desai describes the mechanism by which the electrode is moved into contact with tissue as moving a sliding portion 338 which is moved by the operator along guide rods 334 to extend or retract the electrode 306 (See, e.g., Col. 19, lines1-6). The sentence referred to by the Examiner at lines 31-32 of Col. 19 that reads: "Spring loaded contact mechanisms can also be used and are included in the invention," relates to contact mechanisms for contacting the electrode with the pin, not to any movement of the electrode. No where does Desai show or suggest that the electrode be spring biased and "biased" into the

prostate gland or other tissue upon actuation by a user. Applicants therefore respectfully request the Examiner to withdraw the rejection of the pending claims each of which now includes the spring biasing means or mechanisms for biasing the needle into the prostate gland as being anticipated by Desai.

§ 103 Rejection of the Claims

Claims 2, 9, 11 and 21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over, Desai, U.S. Patent No. 6,231,591, in view of Schmidt, U.S. Patent No. 6,365,164. Applicants respectfully traverse this rejection to the extent such rejection may be considered applicable to the claims as amended. The applied references fail to disclose or suggest the inventions defined by Applicants' claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

As discussed above, Desai fails to disclose spring biasing means or mechanisms for biasing the needle into the prostate gland as found in the amended claims, and nothing in Schmidt discloses describes a system or method such as that found in the claims that includes the use of spring biasing means for biasing a needle having a lumen through which a denervating agent may be delivered into the prostate gland. Moreover, neither Desai nor Schmidt suggest a method that includes the use of two reservoirs wherein discrete doses of the denervating agent may be delivered wherein the reservoir from which the denervating agent is delivered to the prostate gland is refilled with a second dose from the other reservoir.

For at least these reasons, the current rejection fails to establish a *prima facie* case for non-patentability of Applicants' amended claims 9, 11 and 21, under 35 U.S.C. §103(a). Claim 2 has been canceled. Withdrawal of this rejection is respectfully requested.

In view of the foregoing amendments, Applicants respectfully request reconsideration and allowance of the claims as all rejections have been overcome. Early notice of allowability is kindly requested.

The Examiner is respectfully requested to contact the undersigned by telephone at 763.505.0003 or by E-mail at mary.p.bauman@medtronic.com with any questions or comments.

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Please grant any extension of time, if necessary for entry of this paper, and charge any fee due for such extension or any other fee required in connection with this paper to Deposit

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Respectfully submitted,

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Mary P. Bauman
Mary P. Bauman
Registration No. 31,926
MEDTRONIC, INC.
710 Medtronic Parkway NE, M.S.: LC340
Minneapolis, Minnesota 55432-5604
Telephone: (763) 505-0003
Facsimile: (763) 505-0411
CUSTOMER NO.: 27581